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EXAMINER

CARIASO, ALAN B

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,400

Applicant(s)

DOREATHA L. BATTLE

Examiner

Alan Cariaso

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 18 March 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Drawings

1. The corrected or substitute drawings were received on March 18, 2003. These drawings are disapproved for the following reason below.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the power supply in operative relation with the plurality of light emitting elements and coupled within the housing, the power supply being a battery and solar energy system must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The attempt to incorporate subject matter into this application by reference to US Patent 6,027,225 is improper because the claims depend on structure of the power supply and its relationship to the housing not disclosed in the present application, except by reference to a prior art. Furthermore, the applicant is partly relying alleged novelty on this structure as now claimed.

Claim Objections

4. Claims 9-13 are objected to because of the following informalities:

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5. Claim 9, line 2, the delete-notation "[housing ... portion,]" recited in the clean copy should be removed. In addition, there are two words "the [] the", which are redundant; one of these terms "the" should be deleted.
6. Claim 10 is objected for depending on objected claim 9.
7. Claim 11, lines 11 and 14-15, the "power source compartment" and "the power supply compartment" appear to be directed to the same limitation but are objected for having a difference in terminology. Repeated limitations should have consistent terminology.
8. Claim 11, line 18, the capital "A" should be made lowercase -a--.
9. Claim 11, line 19, there are two periods (..) which are redundant; one period should be deleted.
10. Claims 12 and 13 are objected for depending on objected claim 11.
11. Appropriate correction is required.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
13. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
14. Claims 1, 11 and 14, the limitation "a power supply ... coupled *within* the housing" is indefinite as lacking support from the specification. Furthermore, it is

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unclear how a solar energy system would operate to obtain external energy if as the power supply is coupled within the housing.

15. Claim 18, lines 2-4, the limitation "the plurality of support members" and its "longitude" have no antecedent basis. Preceding claim 14 as amended (by deletion thereof) no longer provides antecedent basis for this limitation in claim 18.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by CHICH et al (US 5,220,739).

18. CHICH discloses a plurality of light emitting elements (24); a housing (164-fig.9) having a front surface (164), a back surface (38), first and second side surfaces (fig.9), top and bottom surfaces (fig.9), a surface (18) of the housing (164) defining a plurality of apertures (166) therethrough; a power supply (26) in operative relation with the plurality of light emitting elements (24) and coupled within (fig.8) the housing (164); wherein the power supply (26) is a battery (col.7, line 15).

19. As for the phrase in claim 1, lines 6-7, "for receiving and retaining in a reversible manner, the plurality of light emitting elements", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention

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and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

20. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by AMBROSINO (US 5,582,478).

21. AMBROSINO discloses a plurality of light emitting elements (18,20-fig.1); a housing (16) having a front surface (30-fig.2), a back surface (12), first and second side surfaces (26), top and bottom surfaces (adjacent to 32-fig.1), a surface (30) of the housing (16) defining a plurality of apertures (48,49,51-fig.2) therethrough receiving and retaining in a reversible manner the plurality of light emitting elements; a power supply (38) in operative relation with the plurality of light emitting elements (18,20) and coupled within the housing (16-fig.2); wherein the power supply (38) is a battery (fig.2); wherein the housing (16) is formed from a translucent polymeric material (col. 6-9) that is inherently and relatively sturdy and shatter resistant.

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 1-3, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over ARIE et al (US 6,092,318) in view of WINTERER (US 5,664,874).

24. ARIE discloses a plurality of light emitting elements (6-fig.1); a housing (1) having a front surface (3), a back surface (4), first and second side surfaces (5), top and bottom surfaces (5,2), a surface (3) of the housing (1) defining a plurality of apertures (col.8, lines 19-22) therethrough; a power supply (8) in operative relation (fig.2) with the plurality of light emitting elements (6) and coupled with the housing (1); wherein the power supply (26) is a battery and solar energy system (8); wherein the back surface (fig.5) has a cover portion (381c-figs.5 & 11) that substantially covers the back (col.15, lines 3-5) of the housing (312), the cover portion (381c) being removable; wherein the back surface (fig.5) of the housing (312) further comprising a power source compartment (316) having a cover portion (381c) that is removable.

25. However ARIE does not disclose coupling of the battery or solar power supply within the housing. WINTERER teaches an outdoor lighting device that includes a solar powered battery assembly (fig.8) coupled within the housing (18-figs.3 & 7) for the purpose of solar-rechargeably powering batteries to operate light sources (38-fig.9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the outdoor lighting display of ARIE et al to include the type of internally coupled power supply in the lighting housing as taught by WINTERER in order to protect at least the rechargeable batteries from the ambient elements.

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26. Claims 1, 2, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WILLIAMS (US 5,097,612) in view of GOETTEL-SCHWARTZ (US 5,575,098).

27. WILLIAMS discloses a plurality of light emitting elements (22,24,26); a housing (16-fig.7) having a front surface (14-fig.6), a back surface (right surface designated 16-fig.7), first and second side surfaces (left and right edges -fig.6, having some surface as seen on fig.7), top and bottom surfaces (fig.6), a surface (at least front surface 14) of the housing (16) defining a plurality of apertures therethrough (col.3, lines 65-67) receiving and retaining the plurality of light emitting elements (22,24,26); a power supply (col.5, lines 18-24) in operative relation with the plurality of light emitting elements (22,24,26); further comprising a hook (37) coupled with a portion of the housing (16); further comprising a plurality of support members (34,35) coupled with a portion of the housing (16).

28. However, WILLIAMS does not disclose the power supply coupled within the housing. GOETTEL-SCHWARTZ teaches batteries (46,48,50,52) coupled within space between a front surface (12) and back surface (20) of a lighted display for the purpose of operatively powering the plurality of light emitting elements (40). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lighting display of WILLIAMS to include the type of sandwiched batteries coupled within housing surfaces as taught by GOETTEL-SCHWARTZ in order to facilitate powering the light emitting elements and portability of the display without making an external connection to a power source.

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29. Claims 14-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over GRIEB et al (US 4,974,129) in view of GODFREY et al (US 4,443,831).

30. GRIEB discloses a light emitting element (27), a sturdy plastic housing (13, col.3, lines 7-8), the housing (13) defining an aperture (29) therethrough for receiving and retaining in a reversible manner, the light emitting element (27); a flange portion (45,55-figs.3-4 or 37,65-figs.2-3) coupled with a portion of the housing (13-figs.2-6); a solar power supply (35-figs.6 & 9) in operative relation (fig.9) with the light emitting element (27) and coupled with the housing (13-fig.6); wherein the housing (13) further comprises a switch (81) operatively connected to the light emitting element, to turn the light emitting element to an on or off configuration; wherein the solar power supply (fig.9) further comprises a rechargeable battery (34); wherein at least one support member (37,59) comprises an actuator (71).

31. However, GRIEB does not disclose a plurality of light elements disposed in corresponding plurality of apertures in the housing. GODFREY teaches a plurality of light emitting members (22,24-figs.7-8) disposed in corresponding plurality of apertures (44) in the housing (12,14) for the purpose of providing adjustable or directable illumination within an interior of the vehicle. Furthermore, GODFREY teaches at least support member (32, col.2, lines 31-52) for the purpose of positioning the lighting device onto a window (col.2, lines 51-52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the solar-rechargeable lighting device of GRIEB to include plural light emitting members disposed in plural apertures of the housing as taught in GODFREY in order to further increase the visibility

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of both the lighting device and the interior of the vehicle positioned on or adjacent a window from where the lighting device illuminates.

32. As for the phrases, in claim 14, lines 9-10, "suitable for resting between a bottom portion of a window and window sill", and in claim 18, lines 2-5, "for allowing the housing to move in a telescoping manner along the longitude of the support member so as to allow a the light emitting elements to be displayed a variety of different heights with respect to the window parapet", any recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Allowable Subject Matter

33. Claims 11-13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

34. Claims 7, 8, 17, 19 and 20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Response to Arguments

35. Applicant's arguments, filed March 18, 2003, with respect to the rejection(s) of claim(s) 1-20 under ABTAHI and CHEN have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of CHICH et al, AMBROSINO, ARIE et al in view of WINTERER, WILLIAMS in view of GOETTEL-SCHWARTZ, and GRIEB et al in view of GODFREY et al.

Conclusion

36. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. CLIFT et al (US 6,497,502) show a flange portion (26a-d, figs.2,4) coupled to a plastic housing (18,20) resting between a bottom portion of a window (12) and window sill (34) and a circuit means (col.6, lines 3-16) operably couples with a light emitting element (24) disposed within a plastic housing (18,20) wherein the light emitting element illuminate when it is substantially dark and do not illuminate when it is substantially light, including a solar power supply (col.3, lines 20-27) and a rechargeable battery (col.3, lines 25-29). CAMPBELL, III (US 6,098,326) shows a window locator sign (2) having a sturdy plastic housing (10) that includes plural apertures (14) on a surface and plural light emitting elements (30,31) housed therein. SHYU (US 5,007,190) shows solar collectors (121) and batteries (4) coupled onto and within a lighted display housing, respectively, and including a circuit with ambient light sensor (2). SOWLE (US 3,762,119) shows a housing with plural apertures occupied by

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plural light bulbs (20), the housing having support members that include a hanger (64) and flange (62) securing the housing adjacent a window (10), and height adjusting telescoping supports (104,114) with an actuator (106).

37. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cariaso whose telephone number is (703) 308-1952. The examiner can normally be reached on M-F (9:00-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (703) 305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.



Alan Cariaso
Primary Examiner
Art Unit 2875

AC
May 23, 2003